

### **REMARKS**

The Office Action dated May 14, 2004, has been received, its contents carefully noted, and the applied citations thoroughly studied. Accordingly, the foregoing revisions to the claims are tendered with the conviction that patentable contrast has now been made manifest over the known prior art. All rejections tendered by the Examiner in the above-referenced Office Action are hereby respectfully traversed and reconsideration is respectfully requested.

It is believed that the foregoing revisions to the claims are within the metes and bounds of the recently articulated Supreme Court *Festo* case, in that all equivalents susceptible to capture have been retained in that one skilled in the art, at the time of this amendment, could not have reasonably be expected to have drafted a claim that would have literally encompassed any other equivalent.

### **Double Patenting**

The Examiner has provisionally rejected claims 11 through 18 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 through 15 of Application Serial No. 09/430,390 (now U.S. Patent 6,695,290). Applicant is willing to consider filing a terminal disclaimer after all other issues are resolved and the double patenting rejection is the sole remaining issue.

### **Rejections under 35 U.S.C. § 102**

The Examiner has rejected claims 11 through 12 and 16 through 17 as being anticipated by Lewis (USP 4,616,970).

At the outset, Lewis does not disclose a lifting jack accessory. as required by claim 11. Therefore, anticipation is legally incorrect. Lewis discloses only a spacer block for a tow bar (col. 1, lines 50-52). The spacer block protects the towed vehicle and prevents it from slipping while it is being towed (col. 2, lines 4-8). See, e.g., figures 5-7 of Lewis, showing how the spacer block is interposed between the tow bar and the vehicle.

The preamble of each claim breathes life into the claim, locating it in its environment. The lifting jack accessory of the present invention is used with a lifting jack, while Lewis' spacer block cannot possibly serve the same function. The size and shape of Lewis' spacer block renders it unsuitable for such use with a lifting jack. Lewis' tool has no relevance whatsoever to lifting jacks.

The Examiner claims:

Lewis discloses a lifting jack accessory having a sleeve means (the inside area of elements 14 and 16), an adjunct (12) with a clevis hole (62 which has a hole but not a through hole), a spike (which is the point of 44, by definition a spike is just a sharpe [sic] point), a plurality of teeth (21), and a nose (which is just one of the top corners of the adjunct).

Claim 11 requires "A lifting jack accessory comprising, in combination: a sleeve having first and second ends and an adjunct projecting from a side of said sleeve including means for engaging other objects therewith".

As noted hereinabove, Lewis does not disclose a "lifting jack accessory".

The Examiner characterizes reference numeral (12) in Lewis as "an adjunct". However, Lewis uses reference numeral (12) to denote the "spacer block" itself (e.g., column 2, lines 36, 37). The adjunct of the present invention is a portion of the invention the projects outwardly, as described in the specification beginning at page 11, line 5. Perhaps the Examiner is referring to the portion of the spacer block

including face (20). Face (20) does not “project” from the sleeve portion, as required by the claim. Reference numeral (20) refers to one of the four faces (20),(22),(24),(26) surrounding the rectangular hole (16) in the spacer block.

Lewis does not disclose all the elements of claim 11, and thus, Lewis cannot anticipate claim 11.

Claim 12 depends from claim 11 further requires that the “adjunct include[] a clevis hole for receiving shackle rigging”. Lewis characterizes reference numeral (62) as “a central web”, which also has webs (64) that intersect perpendicularly with it. As the Examiner notes, (62) “has a hole but not a through hole”. If the “hole” in Lewis is not a “through” hole, how can it possibly “receive shackle rigging”, as specifically stated by the claim? Nothing can be received by a hole that is not a “through” hole.

Lewis does not disclose all the elements of claim 12 or the claims preceding it, and thus, Lewis cannot anticipate claim 12.

With respect to claim 16, the Examiner’s kind attention is drawn to the fact that claim 16 depends from claim 15, which is not rejected for any other reason than double patenting. If claim 15 is otherwise patentable, it is impossible for claim 16 to be anticipated by any reference.

Claim 16 includes the limitations of the unanticipated claim 15, which depends from claim 12 and further requires “a spike on said adjunct at a remote end thereof”. The Examiner characterizes “the point of 44” as the spike, noting that “a spike is just a sharp point”. The figures in Lewis reveal no “sharp point” associated with numeral (44); by the Examiner’s own words, numeral (44) cannot be a “spike”. Reference numeral (44) is described as a “stop”, which “extends behind the bumper to prevent the tow bar assembly from sliding forwardly and being dislodged from

underneath the bumper". The function of stop (44) would thwart the purpose of Lewis' invention if it were a "spike" Lewis is intended to prevent damage and slippage when a vehicle is being towed. Having an outwardly projecting spike in the position of stop (44) would damage the towed vehicle by its very placement.

Lewis does not disclose all the elements of claim 16 or the claims preceding it, and thus, Lewis cannot anticipate claim 16.

Claim 17 depends from claim 11 and further requires "a plurality of teeth on one surface of said adjunct". Lewis's grooves (21) should not be considered the same as the teeth of the present invention, because the term "teeth" refers to pointed protrusions, and Lewis's grooves are specifically disclosed as having a "flat" surface. Even if Lewis's grooves (21) may be considered "teeth", as noted in the previous paragraph, the grooves (21) are not located "on one surface of said adjunct", as required by the claim language, because there is no "adjunct" in Lewis.

The Examiner includes a characterization of "one of the top corners of the adjunct" in Lewis as a "nose". Perhaps the Examiner intended to include claim 15 in the anticipation rejection with respect to Lewis, as no other claim includes a "nose". Because Lewis has no "adjunct", it cannot have a nose on an adjunct. The portion of Lewis that the Examiner discusses is merely a "face" of the spacer block, with the Examiner locating the nose of the present invention on a corner of the spacer block. Clearly, Lewis does not anticipate claim 15.

The Examiner has also rejected claims 11 through 13 and 16 as being anticipated by Akrep (USP 6,102,351).

As noted hereinabove, the instant claims are directed to a lifting jack accessory. Akrep discloses a "uniform section rotary spreader beam", which is used

in “the industry of suspending and focusing loads such as audio or video devices in a theater or concert hall” (col. 1, lines 7-9). Akrep has no relevance whatsoever to a lifting jack, and it is inconceivable how Akrep would be used with a lifting jack. Akrep includes two hollow tubes that are joined by an axle with friction bearings, which allows the tubes to rotate relative to one another.

The preamble of each claim breathes life into the claim, locating it in its environment. The lifting jack accessory of the present invention is used with a lifting jack, while Akrep’s rotary spreader beam cannot possibly serve the same function. Akrep’s invention has no relevance whatsoever to lifting jacks.

The Examiner states:

Akrep discloses a lifting jack accessory having a sleeve means (the inside area of elements 19 and 20 which is the inside of the tube), an adjunct (15) with a clevis hole (6) a chain lock (10), a spike (which is just one of the top corners of the adjunct), and a nose (which is other of the top corners of the adjunct).

Claim 11 requires “A lifting jack accessory comprising, in combination: a sleeve having first and second ends and an adjunct projecting from a side of said sleeve including means for engaging other objects therewith”.

As noted hereinabove, Akrep does not disclose a “lifting jack accessory”. Akrep cannot be used with a lifting jack in any manner .

Claim 12 depends from claim 11 and further requires that the “adjunct include[] a clevis hole for receiving shackle rigging”. There is no possible use for shackle rigging with respect to Akrep. The limitation of “a clevis hole for receiving shackle rigging” makes no sense in the context of Akrep.

Claim 13 depends from claim 11 and further requires that the “adjunct include[] a chain lock means”. There is no “chain lock means” in Akrep. There are a

plurality of holes that have objects connected through them, but no chain lock means. Even if a chain were to be passed through one of the holes, there is disclosed no means whatsoever for "locking".

As noted hereinabove, the Examiner's kind attention is drawn to the fact that claim 16 depends from claim 15, which is not rejected for any other reason than double patenting. If claim 15 is otherwise patentable, it is impossible for claim 16 to be anticipated by any reference.

Claim 16 includes the limitations of the unanticipated claim 15, which depends from claim 12 and further requires "a spike on said adjunct at a remote end thereof". The Examiner persists on characterizing a corner as a "spike". A spike is a protrusion; the Examiner characterizes a "spike" as a "sharp point" in describing Lewis. Even by the Examiner's definition, there is no sharp point in Akrep.

Further, claim 15 refers to a "nose" and is not included in the Examiner's rejection. its inclusion in the Examiner's description of Akrep as noted hereinabove indicates that the Examiner may have intended to include claim 15 in the rejection using Akrep. The Examiner characterizes the "other" corner in Akrep as the "nose". A "nose", like a "spike" is a protrusion, though a "nose wouldn't necessarily be a "point". A nose must be a protrusion, however, which the corners of Akrep are not, as is revealed in the figures of Akrep..

With respect to rejections under 35 U.S.C. § 102, the Examiner is invited to consider the following binding, compelling precedent articulated by the Court of Appeals for the Federal Circuit:

“ . . . anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference.” *Akzo N.V. v. United States ITC*, 808 F.2d 1471, 1 U.S.P.Q.2d 1241 (Fed. Cir. 1986).

Further, “those elements must either be inherent or disclosed expressly . . .” *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 2 U.S.P.Q.2d 1051 (Fed. Cir. 1987). “ . . . and must be arranged as in the claim[s] . . .” *Carella v. Starlight Archery & Pro Line Co.*, 804 F.2d 135, 231 U.S.P.Q. 644 (Fed. Cir. 1986).

In addition, “ . . . [the] absence from the reference of any claimed element negates anticipation.” *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 U.S.P.Q. 81 (Fed. Cir. 1986).

Binding precedent has established that functional language deserves full weight in analyzing the merits of claimed language. The Court of Appeals for the Federal Circuit has stated that to disregard functional language “flies in the face of the ‘all elements’ rule of claim construction” *Hollister Inc. v. E.R. Squibb & Sons Inc.*, 14 U.S.P.Q.2d 2069, 2070 (C.A.F.C. 1990). “We are aware that functional language such as that here at issue (‘permitting easy removal of a single tag pin from the assembly and removal of an assembly of tag pins...’) is allowed in claims and is entitled to full weight in claim analysis” *Clements Industries Inc. v. A. Meyers & Sons Corp.*, 12 U.S.P.Q.2d 1874, 1877(S.D.N.Y. 1989), citing *In re Swinehart*, 169 U.S.P.Q. 226 (C.C.P.A. 1971).

In fact, the Patent and Trademark Office Board of Appeals has stated by published opinion that “functional language in the claims must be given full weight and may not be disregarded in evaluating the patentability of the subject matter defined employing such functional language.” “However, the applicant

must establish that what is taught by the reference does not inherently function in the manner required by the claim" *Ex Parte Bylund*, 217 U.S.P.Q. 492, 498 (Patent and Trademark Office Board of Appeals 1981).

"It is well settled that there is nothing intrinsically wrong in defining something by what it does rather than what it is." *In re Hallman*, 210 USPQ 609, 611 (C.C.P.A. 1981).

Little or no weight has been given to the language of the claims that is functions or describes the environment of the invention. As the precedent above recites, such language must be fully considered. It is clear that neither Lewis nor Akrep contains each element of any of the disputed claims, and thus, withdrawal of the rejections under 35 U.S.C. §102 is mandated.

The Examiner is kindly invited to note that claim 11 has been amended to make explicit that which was heretofore only implicit. It is believed that amended claim 11 makes clear the manner in which the present invention differs from the cited prior art and additionally addresses the Examiner's particular concerns as enunciated in the May 14, 2004, Office Action.

The Examiner is respectfully requested to note that the Office Action to which this amendment responds was mailed on May 14, 2004, thereby requiring a response on November 14, 2004. November 14, 2004, was a Sunday. Therefore, this amendment is timely filed on Monday, November 15, 2004.

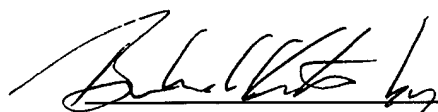
In view of the foregoing, it is respectfully requested that the Examiner pass this case to issue. If, upon further consideration, the Examiner believes further issues remain outstanding or new ones have been generated, undersigned

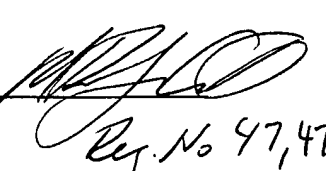


respectfully requests that the Examiner call undersigned to expeditiously resolve same.

Dated: November 15, 2004

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